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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/552,823	04/20/00	PACIFICI	M 17327CIP (HL)

ALLERGAN INC
2525 DUPONT DRIVE
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HM12/0214

EXAMINER

FAY, Z

ART UNIT

PAPER NUMBER

1614

3

DATE MAILED:

02/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/552,823

Applicant(s)

Pacifici et al.

Examiner

Zohreh Fay

Group Art Unit

1614



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-11 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-11 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

Claims 1-11 are presented for examination.

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for certain cartilage or bone pathologies, does not reasonably provide enablement for the treatment of all the disorders covered under the broad phrase of "a cartilage or bone pathology". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The instant specification fails to provide support or guidance to use the claimed compounds for the treatment of all cartilage or bone disorders. Without such support one skilled in the art could not predict which disease or pathology a retinoid agonist would be effective for. Accordingly one skilled in the art could not predict which disorder out the vast numbers of potential disorders can be treated with different retinoid acid agonist.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103 as being unpatentable over Margolis.

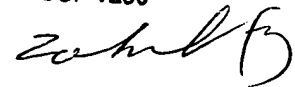
Margolis teaches the use of retinoids for the treatment of osteoporosis. See the entire document. One skilled in the art would have been motivated to employ the teachings of the above reference since it relates to the use of the retinoids for the treatment of osteoporosis. It would have been obvious to a person skilled in the art to use a retinoid agonist for the treatment of a

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bone pathology, considering that the prior art teaches that retinoids have been previously used for the treatment of a bone disorder. Applicant has presented no evidence to establish the unexpected or unobvious nature of the claimed invention, and as such, claims 1-11 are properly rejected under 35 U.S.C. 103.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Fay whose telephone number is (703) 308-4604.

ZOHREH FAY
PRIMARY EXAMINER
GROUP 1200



Z.F